

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re

Decision on
Petition for Regrade
Under 37 C.F.R. § 10.7(c)

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MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 1, 20, and 32 of the morning session and questions 38, 41, and 42 of the afternoon session of the Registration Examination held on April 21, 1999. The petition is denied to the extent Petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On August 2, 1999, Petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect

answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of Petitioner’s arguments have been considered. Each question in the examination is worth one point.

Petitioner has been awarded points for morning question 20 and afternoon questions 28 and 38 because these questions have been eliminated from the examination. Accordingly, Petitioner has been granted an additional three points on the examination, resulting in a regraded score of 69. However, no credit has been awarded for morning questions 1 and 32 and afternoon questions 41 and 42.

Morning question 1 reads as follows:

1. P, a registered patent practitioner, filed a reply to a first Office action which rejected all claims under 35 U.S.C. § 102(a) based on an earlier patent granted to Z. The Office Action was dated September 15, 1998 and set a three month shortened statutory period for reply. P's unsigned reply, filed February 3, 1999, did not include a petition for an extension of time and contained only the following paragraph:

Applicant respectfully spits on the ludicrous position taken by the Examiner in rejecting all claims under 35 U.S.C. § 102(a) based on an invalid patent granted to Z. Applicant may be willing to overlook the Examiner's stupidity in making this rejection since it is possible that the Examiner was unaware that Z is a bum and a thief who stole Applicant's invention. Applicant has renumbered the claims and have attached a copy of Z's patent with notations made thereon. Applicant respectfully requests that the Examiner "WAKE UP" and take another look at Applicant's claims in light of those remarks. Please charge my deposit account number 99-1234 to cover the cost of any required fees.

P should not be surprised when the amendment is not entered because:

- (A) The reply was not signed.
- (B) An amendatory paper determined to contain objectionable remarks will be returned to sender.
- (C) P did not file a petition for an extension of time.
- (D) (A) and (B) are correct.
- (E) (A), (B) and (C) are correct.

Choice (D) is correct because both choices (A) and (B) are correct. A reply that is not signed is not entered, but applicant is given an opportunity to ratify the reply. See Manual of Patent Examining Procedure (MPEP) § 714.01(a). A reply determined to contain objectionable marks will be returned. See 37 CFR § 1.3. Choice (C) is not correct because a general authorization to charge a deposit account is a request for an extension of time, albeit an unsigned one in this instance. See 37 CFR § 1.136(a)(3).

Petitioner contends that choice (E) is the correct answer because choice (C) is also correct along with choices (A) and (B). Petitioner argues that P's request to "charge my deposit account number 99-1234 to cover the cost of any required fees" was not a constructive petition for an extension of time because the PTO was not "authorized" to charge any fees to P's deposit account without P's signature.

Petitioner's arguments are not persuasive. The question asks why the amendment is not entered. When the deposit account is properly charged is a different issue. 37 CFR § 1.136(a) provides a statement of authorization to charge all required fees will be treated as a constructive petition for an extension of time. Since the reply contained a statement of authorization to charge any required fees, a constructive petition for the extension of time was included in the reply. Accordingly, the amendment is not entered because of the reason other than P did not file a petition for an extension of time. In this fact pattern, the reasons the amendment is not entered are the reply was not signed and the reply contains objectionable remarks. See MPEP §§ 714.19 (E) & (K) and 714.25. Choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on question 1 is denied.

Morning question 32 reads as follows:

32. XYZ Corporation has hired you to draft and file a patent application relating to a steel alloy. You diligently prepare the application and file it in the PTO on June 23, 1998, naming Baker as the inventor. On February 5, 1999, you receive a first Office action rejecting all the claims under 35 U.S.C. § 102(g)/103 over a patent assigned to XYZ Corporation. Able is the inventor named in the patent. The Able patent was granted on an application filed on June 25, 1996, and issued on January 13, 1998. You can overcome this rejection by _____

- (A) filing an affidavit signed by an officer of the XYZ Corporation averring that both Able and Baker were subject to an obligation of assignment on the date the later

- invention was made, and stating facts which explain the officer's belief of ownership.
- (B) filing an affidavit by Baker averring common ownership on the date of filing the Able patent application with the necessary fee.
 - (C) filing a terminal disclaimer so as not to extend the term of the Baker application beyond that of the Able patent if the Baker application matures into a patent.
 - (D) filing a request to suspend the prosecution of the Baker patent application, and petition the Commissioner for a corrected filing receipt dated January 13, 1998, because of common ownership.
 - (E) filing a request for reexamination of the Able patent based on prior art references not disclosed by Baker.

Choice (A) is the best course of action to overcome the 102(g)/103 rejection. As explained in MPEP § 706.02(I), "35 U.S.C. § 103(c) which provides that subject matter developed by another which qualifies as "prior art" only under subsections 35 U.S.C. § 102(f) or 35 U.S.C. § 102(g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. § 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made" (emphasis added). By filing the affidavit provided in choice (A), the response would properly disqualifies the Able reference as a prior art under 35 U.S.C. § 103, overcoming the 102(g)/103 rejection. See MPEP § 706.02(I).

Petitioner selected choice (B) and contends that "there was no correct answer to the question listed." Petitioner argues that "answer (A) will NOT overcome the rejection" because the subject matter in the Able patent qualifies as prior art under other subsection such as 35 U.S.C. §§ 102(a) and 102(e).

Petitioner's arguments are not persuasive.⁴ Petitioner's argument that choice (A) will not overcome the rejection because another rejection would be appropriate is not persuasive. The question was not whether the answer would overcome any appropriate rejection, it was only whether the answer would overcome the rejection under 35 U.S.C. § 102(g). Choice (B) cannot

overcome a 102(g)/103 rejection because the affidavit that establishing the common ownership is signed by Baker. The facts of the question do not show Baker is an official of the XYZ corporation or is empowered to act on behalf of the corporation. See MPEP § 706.02(I), item II (B). Thus, choice (B) is not the correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. Which of the following choices would be considered as independent grounds for filing a reissue application?

- (I) The claims are too narrow or too broad.
 - (II) The disclosure contains inaccuracies.
 - (III) Applicant failed to or incorrectly claimed foreign priority.
 - (IV) The specification contains a plurality of obvious spelling and grammatical errors.
 - (V) Applicant failed to make reference to or incorrectly made reference to prior copending applications.
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- (A) (I),(II), and (IV)
 - (B) (II),(III), and (V)
 - (C) (I),(II), (III), (IV) and (V)
 - (D) (I),(II), (III), and (V)
 - (E) (I),(III), and (V)

The correct answer is (D) because choices (I), (II), (III), and (V) would be considered as independent grounds for filing a reissue application, but not choice (IV). As explained in MPEP § 1402, "The most common bases for filing a reissue application are: (A) the claims are too narrow or too broad; (B) the disclosure contains inaccuracies; (C) applicant failed to or incorrectly claimed foreign priority; and (D) applicant failed to make reference to or incorrectly made reference to prior copending applications." Accordingly, choices (I), (II), (III), and (V) are correct.

Choice (IV) is not correct because the defect given in choice (IV) does not cause the patent to be deemed wholly or partly inoperative or invalid. MPEP § 1402 provides

In accordance with 35 U.S.C. § 251, the error upon which a reissue is based must be one which causes the patent to be “deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent.” Thus, an error under 35 U.S.C. § 251 has not been presented where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. § 251. These corrections to a patent do not provide a basis for reissue.

Petitioner selected answer (C) and argues that choice (IV) is an independent ground for filing a reissue application. Petitioner contends “[c]hoice (IV) does not however, state that the spelling and grammatical errors in the patent have NOT caused the patent to be rendered wholly or partly inoperative or invalid.” According to the Petitioner, “[n]ot a single choice considered by the Office to be a correct answer (i.e., (I), (II), (III), and (V)) states that the defect recited caused the patent to be rendered wholly or partly inoperative or invalid.” Petitioner further infers that the defect recited in choice (IV) caused the patent to be rendered wholly or partly inoperative or invalid.

Petitioner’s arguments are not persuasive. The MPEP § 1402 specifically listed the most common bases for filing a reissue application as stated above. The nature of these grounds meets the requirement sets forth in 35 U.S.C. § 251, therefore these common defects recited in choices (I),(II),(III), and (V) do not need to state specifically that they cause the patent to be rendered wholly or partly inoperative or invalid. Contrary to these common bases, a plurality of obvious spelling and grammatical errors in the specification, the defect recited in choice (IV), generally would not cause the patent to be rendered wholly or partly inoperative or invalid. As explained in

MPEP § 1402, “an error under 35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251.” Accordingly, the defect recited in choice (IV) is not an independent grounds for filing a reissue application. Therefore, answer (C) is not correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 42 reads as follows:

42. On April 19, 1999, Inventor Mary hires you for advice on a patent application. Mary informs you that she previously filed a provisional application for her invention on May 1, 1998. However, Mary has since made some improvements that were not described in her provisional application. To fully protect Mary’s patent rights, what is the best course of action to recommend to Mary?

- (A) File an amendment in the provisional application on or before May 1, 1999, which describes the improvements made by Mary.
- (B) Immediately file a continued prosecution application based on the provisional application filed on May 1, 1998, and include a preliminary amendment which adds a description of the improvements made.
- (C) File a second provisional patent application which claims the benefit of the May 1, 1998, filing date of the first provisional patent application.
- (D) File a continuation-in-part application as soon as possible which adds a disclosure of the improvements made.
- (E) None of the above.

Choice (E) is the most correct answer because choices (A), (B), (C), and (D) are not in accordance with proper PTO practice and procedure. Choice (A) is not correct because an amendment to the provisional application describing the Mary’s improvements would not comply with 37 CFR § 1.53(c). 37 CFR § 1.53(c) sets forth that “[n]o amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.”

Choice (B) is not correct because a continued prosecution application (CPA) may not be based on a provisional application and a continuation-in-part may not be filed as a CPA. See MPEP § 601.01 (page 600-7). 37 CFR § 1.53(d)(1) sets forth that “[a] continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application”. Furthermore, the preliminary amendment which adds a description of the improvements made would introduce new subject matters.

Choice (C) is not correct because a provisional application is not entitled to the benefit of the earlier filed provisional application. 35 U.S.C § 111(b)(7) sets forth that “NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE. – A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.” Therefore, the second provisional patent application cannot claim the benefit of the May 1, 1998, filing date of the first provisional patent application.

Choice (D) is incorrect because a continuation-in-part application cannot base on Mary’s provisional application filed on May 1, 1998. As explained in MPEP § 201.08, “[a] continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application.”

Petitioner selected choice (D) and contends that “the express requirements of 35 USC [§] 120 governing the filing of continuation-in-part (“CIP”) applications are met, and nowhere in title 35 of the United States Code, including 35 USC § 120, are provisional applications removed the type of applications upon which a CIP application may be based.” Petitioner concludes that “the express provisions of 35 USC § 120 directly support claiming priority on an earlier filed provisional application.” Petitioner further maintains that “Congress could have but did not

amend § 120 to exclude claiming priority on a provisional application. Instead, Congress drafted § 111(b) so that provisional applications fall within the express terms of 35 USC § 120.”

Petitioner’s arguments are not persuasive. Choice (D) does not comply with proper PTO practice and procedure. As stated in the Examination Directions, “[t]he most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP).” 35 U.S.C. § 119(e) allows applicants to claim the benefit of priority in a provisional application. Also see MPEP § 201.04(b). 35 U.S.C. § 119(e) sets forth that “[a]n application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title...shall have the same effect...as though filed on the date of the provisional application.” Therefore, contrary to Petitioner’s interpretation that 35 U.S.C. § 120 supports claiming priority to an earlier-filed provisional application, the priority claim to a provisional application is made under 35 U.S.C. § 119(e).

As explained in MPEP § 201.08, “[a] continuation-in-part is an application filed during the lifetime of an earlier **nonprovisional** application” (emphasis added) and “[a]n application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a ‘continuation-in-part’ of the provisional application since the application will have its patent term calculated from its filing date.” Thus, the MPEP § 201.08 clearly sets forth that a continuation-in-part application is based on a **nonprovisional** application and not a provisional application.

Petitioner’s argument that the priority claim to the provisional application is properly made under 35 U.S.C. § 120 is not persuasive. Choice (D) does not comply with the procedure

sets forth in the MPEP and is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

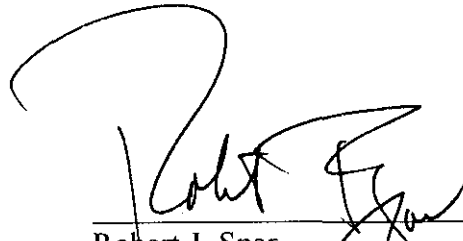
No error in grading has been shown as to questions 1 and 32 of the morning session and questions 41 and 42 of the afternoon session. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, three points have been added to Petitioner's score on the Examination. Therefore, Petitioner's score is adjusted to 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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